

REMARKS

The Examiner continued the objection to the February 7, 2008 declaration because it recited the "material to the examination" language, not the "material to patentability" language as set forth in 37 C.F.R. 1.63. This objection is respectfully traversed.

A notice set forth in the Official Gazette at 1327 O.G. 112 dated 12 February 2008 stated that:

"For pending applications, the Office is hereby *sua sponte* waiving the express language requirement of 37 C.F.R. 1.63(b)(3), where the oath or declaration was filed prior to June 1, 2008. The express language of 37 C.F.R. 1.63(b)(3) is waived only to the extent necessary such that an oath or declaration containing the "material to examination" or "in accordance with §1.56(a)" language, or both, will be accepted as acknowledging the applicant's duty to disclose information "material to patentability" as defined in 37 C.F.R. 1.56. "

Because the declaration on February 7, 2008 contains the acceptable "material to the examination" language and was filed prior to June 1, 2008, the objection is untenable and should be withdrawn. Additionally, any defect in the declaration filed on February 7, 2008 was cured by the declaration filed with the original application on August 24, 2001 and the substitute declaration filed on November 24, 2003, both of which contain the correct language set forth in 37 C.F.R. 1.63. For this additional reason, any potential defect in the substitute declaration filed on February 7, 2008 is cured by the correct language used in the two earlier declarations.

The rejections of the claims based upon a defective declaration are also untenable and should be withdrawn for the same reasons set forth above.

The Examiner also rejected the Claim 48 as improperly recapturing broadened subject matter surrendered in the application for the patent upon which the present reissue is sought. Specifically, the Examiner referred to arguments made in an amendment dated December 14, 1998 ("the 1998 amendment") as evidencing this surrender. This rejection is respectfully traversed.

The applicants agree that the claims of a reissue application cannot cover subject matter that was surrendered in order to obtain allowance of the claims of the original patent. "Under the recapture rule, a patentee is precluded 'from regaining the subject matter that he surrendered in an effort to obtain allowance of the original claims.'" North American Container, Inc. v. Plastipak Packaging, Inc., 415 F.3d 1335, 1349 (Fed. Cir. 2005). As described in that case, the recapture rule is applied by means of a three-step process:

- (1) determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims;
- (2) determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and
- (3) determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule.

In the present application, at least the second step of this rule has not been met. Therefore, the rejection that Claim 48 improperly recaptures broadened subject matter surrendered in the application does not apply.

In the 1998 amendment, applicants indicated that the Steiner et al. reference ("Steiner") includes different types of sensors: (1) sensors 76, 77, whose output is a measure of the brake pressure required by the driver; and (2) a position sensor 71. The applicants argued in that 1998 amendment that there is no suggestion [in Steiner] of blending the pressure [signal, from sensors 76 and 77] and position signals [from sensor 71], and in particular there is no suggestion to blend the pressure and position signals in the manner recited by Claims 17 and 18.

As the Examiner pointed out in the rejection, claims 17 and 18 do not use the terms "pressure signal" and "position signal." The reason this terminology was used in the argument in the 1998 amendment is because this is the terminology used by Steiner. Steiner did include sensors whose output include pressure (sensors 76 and 77) and

position (sensor 71). The argument made in the 1998 amendment was that Steiner did not include a suggestion to blend the two signals, and in particular made no suggestion to blend two signals in the manner recited by the claims. This argument made in the 1998 amendment was not distinguishing Steiner based on the particular types of signals that Steiner used. As the Examiner indicated, the argument did not include the terms used in the claims being argued. Rather, the argument was distinguishing Steiner based on Steiner not including any suggestion of blending any signals. The broader aspects of Claim 48 do not relate to the subject matter argued in the amendment filed December 14, 1998. Therefore, the arguments cited by the Examiner in connection with Claim 48 do not meet the second step of the test for violation of the recapture rule.

Respectfully submitted,

/richardsmacmillan/

Richard S. MacMillan
Reg. No. 30,085

MacMillan, Sobanski & Todd, LLC
One Maritime Plaza, Fifth Floor
720 Water Street
Toledo, Ohio 43604
(419) 255-5900